

Docket No. F-8789

Scr. No. 10/550,128

REMARKS

Claims 1-20 are now pending in this application. Claims 1-10 are rejected. New claims 11-20 are added. Claims 1-10 are amended herein to place them in better form.

Claims 4-6 and 8-10 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,217,139 (Henriott et al.).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Office Action states that Henriott et al. discloses all the limitations of claims 4-6 and 8-10.

Claim 4 recites a flange which extends toward the drawer. The Office Action takes the position that the portions of the elongate hat section 130 which surrounds groove 132 is a flange which extends toward the drawer. However, the portion of elongate hat section 130 which is in contact with the inner surface of groove 132 is not a flange. The flange portion of elongate hat section 130 is item 142 (see Fig. 41 and column 11, line 63 of Henriott et al.). Item 142 does not extend towards the drawer, as recited in claim 4. The remainder of hat section 130 is not a flange. Accordingly, Henriott et al. does not disclose a flange which extends towards the drawer as recited in claim 4. Claim 1 also includes the recitation of a flange which

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extends towards the drawer and is also distinguishable over Henriott et al. at least for this reason.

Claim 4 also recites ribs. The Office Action considers groove 132 to define ribs. There are no ribs disclosed in Henriott et al. and the outer surface of the groove does not define any ribs. One of ordinary skill in the art would know that the outer surface of a groove is not the same as a rib. Accordingly, Henriott et al. is distinguishable over claim 4 for this reason as well. Claim 1 also recites ribs and is also distinguishable over Henriott et al. at least for this reason.

Claim 4 recites that a first of the ribs abuts a first flange surface and that a second of the ribs abuts a second flange surface. The Office Action states that the alleged ribs described above sandwich the flange and are in contact with a first and second surface of the flange. As stated above, there is no flange inside the groove 132 in Henriott et al.

Accordingly, for the aforementioned reasons, claims 1 and 4 are patentable over the cited art and notice to that effect is respectfully requested. Claims 2-3 and 5-10 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). Regarding claim 8, the Office Action states that "screw-in-part 142" is connected to the flange. Claim 8 recites that the screw-in-part and the flange are connected with a screw that extends from the screw-in-part through the screw insertion aperture. Object 142 in

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Henriott et al. is not connected with a screw to any flange. Accordingly, claim 8 is further patentable for this reason as well.

Claim 10 recites a roller at a first end of the rail. The Office Action has not identified any roller in Henriott et al. and has also not identified a roller at a first end of the rail. Figure 41 of Henriott et al. is a cross-section and is not directed to specifically showing what is at the end of the rail.

Claims 1-3 have been rejected under 35 U.S.C. § 103(a) as obvious over Henriott et al. in view of U.S. Patent No. 6,010,200 (Hays).

The Office Action states that Henriott et al. discloses everything in claims 1-3 except the drawer being made of a synthetic resin. Applicant respectfully disagrees, as explained above regarding at least claim 1.

Additionally, to establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). The Office Action states that Hays shows that it is well known in the art to have a drawer made out of a synthetic resin in order to provide a drawer which is easy to clean, inexpensive to manufacture, and very durable and that therefore it would be obvious to make the drawers of Henriott et al. of synthetic resin.

The Supreme Court has made clear that a claim composed of several elements "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and stated the importance of identifying "a

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reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *See KSR International Co. v. Teleflex Inc. et al.* 82 USPQ2d 1385, 1396 (2007). Henriott et al. specifically discloses that the drawers are made of particle board interior and birch veneer exterior, as disclosed in column 11, lines 47-64 of Henriott et al. The Office Action has not identified any disclosed needs in Henriott et al. that would justify replacing the wood drawers of Henriott et al. with the resin drawers of Hays. Just because Hays discloses resin drawers does not mean that one of ordinary skill in the art would be prompted to replace the specifically disclosed particle board drawers of Henriott et al. with the resin drawers of Hays.

Moreover, the invention of Hays is directed to a plastic drawer and adapter rail which compensates for the draft angle of the sidewalls of the plastic drawer caused by the molds of the drawer. Hays makes clear that the adapter rail is necessary for the drawers to properly fit. The invention of Henriott et al. already has a particular rail and sliding mechanism and there would be no reason for one of ordinary skill in the art to remove the rail and sliding mechanism of Henriott et al. and replace it with the one from Hays in order to accommodate the plastic drawers of Hays in Henriott et al. Also, one of the functions of the elongate hat section 130 in Henriott et al. is to cover the raw particle board surface of the drawer (see column 11, lines 57-60). If a plastic drawer is used in Henriott et al., there would be no reason to cover the raw particle board with the elongate hat section 130 and the

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Office Action's reliance on that section 130 to reject the claims would be inappropriate. Moreover, as disclosed in Hays in column 2, lines 44-51 and as shown in Figure 2 of Hays, the use of the adapter rail in Hays makes the rail structures extend farther away from the drawer. In contrast, the objective of having a groove in Henriott et al. is to save space (see Abstract of Henriott et al.) and the addition of an adapter rail would increase the needed space and would do the opposite of what Henriott et al. seeks to do. Accordingly, Henriott et al. teaches away from being modified to include the resin drawer disclosed in Hays. The Federal Circuit has stated that, as a general rule, references that teach away cannot serve to create a *prima facie* case of obviousness. See *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001). Accordingly, the combination of Henriott et al. and Hays is not appropriate and claims 1-3 are patentable for this reason as well.

Claim 7 has been rejected under 35 U.S.C. § 103(a) as obvious over Henriott et al. in view of Hays. Claim 7 recites that the drawer comprises synthetic resin. The reasons for the patentability of claim 7 over Henriott et al. in view of Hays is similar to the patentability of claims 1-3 over Henriott et al. in view of Hays as described above.

The preambles of claims 1-10 have been amended to recite a rail combination instead of a rail fixing part structure. This amendment is intended to place claims 1-10 in better form since the term "combination" is less awkward than the term "fixing part structure."

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New claims 11-20 have been added and are patentable at least for the reason that they depend from a patentable base claim. Additionally, it is Applicant's position that Henriott et al. in view of Hays fails to disclose or suggest the recitations of claims 11-20.

Support for new claims 11-20 can be found in, for example, the Figures.

Applicant respectfully requests a one month extension of time for responding to the Office Action. **The fee of \$120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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